

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Engelhardt et al.	:	OFFICE OF PETITIONS Ms. Nancy Johnson Senior Petitions Attorney
Application No. 08/486,069	:	
Filed: June 7, 1995	:	
Atty Docket No. ENZ-5(D8)(C2)	:	Confirmation Number: 6728

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION TERMINATING THE ORDER TO SHOW CAUSE

Unfortunately, the USPTO decision mailed February 2, 2010 in the above-captioned application, contains language that offers gratuitous commentary on whether Petitioner met a standard that was not even the standard under which the petition was filed and granted. Accordingly, while Petitioner appreciates the USPTO's willingness to terminate the Order to Show Cause, this Response is being filed to state and to make of record the obvious, i.e., a petition filed under the unintentional delay standard is not required to meet the unavoidable delay standard. In addition to stating the obvious, the gratuitous statement that the evidence presented does not meet the unavoidable delay standard is disturbing in terms of the precedent that it might engender.

Petitioner welcomes the USPTO's reaffirmed recognition that the entire delay in this and the other applications mentioned in the Order to Show Cause ("OSC") was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). Petitioner is concerned, however, by the inaccurate and prejudicial, reference to the

showings in each of the applications subjected to the OSC and their progeny-- which also rely upon those proper revivals.

This application is but one of several applications which were assigned to Petitioner, and despite long ago having become inadvertently abandoned, were all contemporaneously and successfully, petitioned for revival by Petitioner under the “unintentional” provisions of 35 U.S.C. 41 (a)(7) and 37 CFR 1.137(b). Petitioner points out to the USPTO, nevertheless, that it had several instances of applications cited in the OSC wherein Petitioner never either received the initial Office Action, and/or the Notice of Abandonment. As such, Petitioner could have elected to proceed under the “unavoidable delay” revival provisions of 37 CFR 1.137(a) in at least those instances. *However, in each and every application named in the OSC, Petitioner made the decision to petition for revival under, and only under, the “unintentional delay” provisions of 37 CFR 1.137(b) and 35 U.S.C. § 41(a)(7). As such, Petitioner has never presented in any application listed in the OSC, and more importantly, the USPTO has never requested, any showings to be considered under the far more stringent “unavoidable delay” standard.*

It is altogether inappropriate, and unjust, for the USPTO to gratuitously include a comment in the decision to the effect that the record does not show that Petitioner exercised reasonable due care and diligence so as to have avoided abandonment. Petitioner did not make that assertion on petition, did not make a showing to support that assertion, and the USPTO did not ask for a showing of evidence to support that assertion.

Petitioner emphasizes that reasonable due care and diligence are indicia considered under the “unavoidable delay” standard and are immaterial to the “unintentional delay” issue and evidence herein presented, re-presented, and favorably decided in Petitioner’s favor at least twice on the record. Attention is drawn to “Changes to Patent Practice and Procedure; Final Rule,” 62 F.R. 63131 at 53161 (Oct. 10, 1997) and noted:

As “unintentional” delay does not require that the delay have occurred despite the exercise of due care and diligence (as does “unavoidable delay”), the Office does not routinely require a “showing” of unintentional delay for a petition under § 1.137(b)(emphasis added).

It is clear that Petitioner chooses the standard under which relief is requested. In fact, the USPTO itself removed the one year limitation for filing under the unintentional delay standard in part as a cost-cutting measure, in order to steer petitioners from using the unavoidable delay standard to using instead the unintentional standard. Petitioner chose to petition under the unintentional standard in all the cases listed in the OTSC, even though the unavoidable delay standard could have been met in at least some instances.

Petitioner appreciates that the USPTO has also shown a willingness to entertain Petitioner’s previous requests for speedy judgment, and that the USPTO has corrected the fact that the issued OSC compromised the confidentiality of several of Petitioner’s unpublished pending and abandoned applications, and ultimately, that the USPTO again agreed with Petitioner that the delay herein was unintentional. In order to bring proper closure to this matter, the USPTO is urged to agree that the Decision includes unfortunately worded language that is inappropriate.

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Although no fee is believed due for this petition under 37 CFR 1.181, please charge any fees necessary for the grant of this petition Deposit Account No. 50-2929.

Respectfully submitted,

Engelhardt *et al.*



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